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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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**DETAILED ACTION*****Response to Arguments***

Applicant's arguments filed April 28, 2009 have been fully considered, but they are not persuasive. As an initial matter, the examiner provides the following pertinent citations from MPEP 2163 which provide the basis for the 35 USC 112 written description analysis (emphasis provided by the examiner):

Thus, the written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See, e.g., *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads).

The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

Introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement of 35 U.S.C. 112, first paragraph. *In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967) ("If n-propylamine had been used in making the compound instead of n-butylamine, the compound of claim 13 would have resulted. Appellants submit to us, as they did to the board, an imaginary specific example patterned on specific example 6 by which the above butyl compound is made so that we can see what a simple change would have resulted in a specific supporting disclosure being present in the present specification. The trouble is that there is no such disclosure, easy though it is to imagine it.")

See also *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("Whatever may be the viability of an inductive-deductive approach to arriving at a claimed subgenus, it cannot be said that such a subgenus is necessarily described by a genus encompassing it and a species upon which it reads.").

For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention.

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The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See Wertheim, 541 F.2d at 263, 191 USPQ at 97 (“[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”). However, when filing an amendment an applicant should show support in the original disclosure for new or amended claims.

To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim “is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.” Hyatt v. Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). See also In re Wright, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989)

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”)

An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under Vas- Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir.1991)

As an initial matter, applicant argues on pages 2-4 that either hypothetical Figure 2 or amended figure 2 must be correct. The examiner submits that there is no disagreement with the fact that the original specification provides support for an opening at the bottom of the coagulation bath. The issue at dispute is whether the original disclosure expressly, implicitly or inherently discloses that the slot or diaphragm is the same as the discharge opening. In this regard, the examiner maintains the objection to amended Figure 2 and the 35 USC 112 first paragraph rejection of the claims.

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Applicant provides four new arguments that are substantially similar to the previous arguments set forth in the prosecution of this application. Essentially, the examiner maintains that these arguments attempt to employ an inductive approach similar to the arguments previously presented that, while after seeing amended Figure 2, may be conceivably imagined; they do not demonstrate that the original specification described with reasonably clarity the claimed invention such that it reasonably follows that applicant was in possession of the claimed invention at the time of filing. The examiner further submits that what is clearly set forth in the specification supports the rejection. For example, paragraph [0029] recites that "[i]n all embodiments, each of the spinning fields 2 is in combination with a slot or diaphragm 5." while paragraph [0018] recites that "it is preferred to provide the bottom of the coagulation bath per spinning field with an opening." Accordingly, it follows that since each spinning field must be in combination with a slot or diaphragm while it is only preferred that each spinning field is provided with a discharge opening at the bottom of the coagulation bath that the slot or diaphragm does not correspond to the discharge opening as argued.

The examiner submits that the arguments take portions of the specification and concludes that they must be linked such that amended Figure 2 is the clear and only possible result. These arguments are not persuasive. As set forth above, the examiner has provided citations from the specification itself, that do not require forming linkages between disparate sections of the specification, that makes it clear the original specification does not clearly convey or require that the slot or diaphragm is the same as the discharge opening. Therefore, while the sections presented in the arguments are interpreted in view of amended Figure 2, the ability to make such an interpretation itself, no matter how tenuous, after presenting amended Figure 2, does not show that amended Figure 2 or the claims based on amended Figure 2 are

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expressly, implicitly, or inherently disclosed in the original specification such that it is reasonably clear applicant was in possession of the claimed invention at the time of filing.

In arguments one and three, applicant argues that the geometry of the slot is clearly the geometry of the coagulation bath's bottom. This argument is not persuasive. The examiner notes, for example, that hypothetical Figure 2 also reasonably is understood to provide the required geometry. Further, the examiner submits that the linkage of the word "geometry" does not expressly, implicitly, or inherently, link the location of the slot or diaphragm and the discharge opening itself. Further still, the examiner points again to paragraphs [0018] and [0029] as set forth above, which demonstrates that the bottom of the coagulation bath and the slot or diaphragm do not "necessarily" correspond to each other as set forth in the arguments.

Applicant argues that the disclosure of streams flowing in opposite direction with the disclosure of streams coming together at different levels provides evidence that the only logical understanding is that the different heights of the plates at the bottom of the bath create the different levels. This argument is not persuasive. The examiner submits that a variety of other configurations can be considered to meet the scenario set forth in the argument. For example, as the streams flow in opposite directions and hit the walls of the bath they will then move throughout different levels of the bath.

Finally, applicant argues that the disclosure of a "covering plate just above the slot or diaphragm" to close the spinning device makes it clear that the slot or diaphragm is the same as the discharge opening because were that not the case the bath could clearly not be "closed" since the discharge opening would not be covered. This argument is not persuasive. The examiner submits that a very straightforward reading of the citation suggests covering the slot or diaphragm itself separate from any linkage to the opening at the bottom. Simply because the

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discharge opening would not be directly covered in no way requires or implies the argued linkage.

Accordingly, the examiner maintains the rejection of claims 1-7 and the objection to the drawings filed on April 30, 2007.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY WOLLSCHLAGER whose telephone number is (571)272-8937. The examiner can normally be reached on Monday - Thursday 6:45 - 4:15, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Wollschlager/  
Examiner, Art Unit 1791

May 6, 2009